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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Elegant Headwear Co., Inc.

Serial No. 76/409,880

Myron Amer of Myron Amer, P.C. for Elegant Headwear Co.,
Inc.

Michael W. Baird, Trademark Examining Attorney, Law Office
109 (Joan Leslie Bishop, Acting Managing Attorney).

Before Walters, Chapman and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

On May 20, 2002, Elegant Headwear Co., Inc.
(applicant) applied to register the mark BABY'S FIRST (in
typed form) on the Principal Register for goods ultimately
identified as "toddler single-piece sleepwear, baby bibs

not of paper, hats, mittens, sweaters and visors" in International Class 25.¹

The examining attorney ultimately refused to register applicant's mark under Section 2(d) of the Trademark Act (15 U.S.C. § 1052(d)) because of a prior registration for the mark BABY'S FIRST in typed form for "infants' footwear" in International Class 25.²

When the refusal was made final, applicant filed this appeal.

In a case involving a refusal under Section 2(d), we analyze the facts as they relate to the relevant factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); and Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000). In considering the evidence of record on these factors, we must keep in mind that "[t]he fundamental inquiry mandated by § 2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

¹ The application sets out a date of first use and a date of first use in commerce of July 1, 2001. The application contains a disclaimer of the word "Baby's."

² Registration No. 2,396,712, issued October 24, 2000. The registration contains a disclaimer of the word "Baby's."

Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We begin our analysis in this case by comparing the marks in the application and registration and it is obvious that the marks are identical.

Next, we look at whether the goods of applicant and registrant are related. "[E]ven when goods or services are not competitive or intrinsically related, the use of identical marks can lead to the assumption that there is a common source." In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1689 (Fed. Cir. 1993). Applicant's goods are sleepwear for toddlers, baby bibs, hats, mittens, sweaters and visors, while registrant's goods are footwear for infants. Both applicant's and registrant's goods are designed for babies. Indeed, applicant's specimen indicates the size of applicant's product as "0-3 months," and both applicant and registrant have disclaimed the term "baby's." The examining attorney has included copies of sales catalogs that show that clothing items and footwear for babies are sold by the same entities and advertised in the same section of catalogs. See, e.g., OneStepAhead catalog (hats and footwear); L.L. Kids catalog (sweaters and sneakers); and Neiman-Marcus catalog (hats and booties). Applicant's specimen of record also shows that

applicant uses its mark with footwear, i.e., "Headwrap and Ballet Slipper Set." In addition, these catalogs show that footwear for babies includes soft shoes or booties, which are similar to clothing items. See, e.g., OneStepAhead catalog ("These warm, comfy poly-cotton knit booties are brushed inside (just like your favorite sweatshirt) for year-round comfort"). It also is apparent that the purchasers of these products would be similar, i.e., parents and others purchasing clothing including footwear for babies.

Neither registrant's nor applicant's goods are limited to any particular trade channels, therefore, they must be considered to be sold in all normal channels of trade. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("[M]oreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"). There is no basis to find that applicant's and registrant's goods would be sold in distinctly different channels of trade. At the minimum, the channels would overlap.

"In order to find that there is a likelihood of confusion, it is not necessary that the goods or services

on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources." McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). In this case, infants' footwear and toddlers' sleepwear and babies' bibs, hats, mittens, sweaters and visors are closely related such that when identical marks are used on these goods, the public is likely to believe that there is some relationship or association as to the source of the goods.

One final argument that applicant advances "is that BABY'S FIRST is source-identifying to an extent qualifying for registration, but being used by so many unrelated third parties are differentiated from each other by the specific nature of the goods identified." Reply Br. at 1. Applicant points to three other registrations³ for goods in International Classes 11, 21, and 28 (Registration No. 2,169,836); Class 18 (No. 2,330,216); and Classes 20 and 24

³ Kalencom Corporation is identified as the owner of two of these registrations (Nos. 2,330,216 and 2,349,041).

(No. 2,349,041) that the examining attorney cited and four applications that the examining attorney referred to in the first Office Action. However, at the time these registrations and applications were referred to by the examining attorney, the application contained numerous goods that were classified in other classes including receiving blankets, soft toys, wrist rattles, barrettes, and Christmas stockings. When the identification of goods was subsequently narrowed, the other cited registrations were withdrawn. After applicant deleted these goods, the remaining goods (toddler sleepwear, baby bibs, mittens, sweaters, hats, and visors) were still closely related to the goods in the '712 registration (infants' footwear). Therefore, the presence of these additional registrations that involve different goods does not indicate that there is no likelihood of confusion in this case.⁴ Even if these registrations raised doubts about whether there is a likelihood of confusion, we must resolve these doubts against applicant. In re Pneumatiques, Caoutchouc

⁴ The referenced applications are even less relevant. The fact that an application has been filed in the Office is hardly evidence that a term is weak. In this case, one application is abandoned (75/655,291) and the other three involve non-identical marks and different goods and services. The examining attorney determined that there was no likelihood of confusion with these applications after applicant narrowed its goods. See Office Action dated November 29, 2002.

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Manufacture et Plastiques Kleber-Colombes, 487 F.2d 918,
179 USPQ 729, 729 (CCPA 1973).

Decision: The refusal to register under Section 2(d)
of the Trademark Act is affirmed.